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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,036	04/24/2006	Kazunori Yamazaki	053466-0447	9627

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FOLEY AND LARDNER LLP
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EXAMINER

HOLLOMAN, NANNETTE

ART UNIT	PAPER NUMBER
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1612

MAIL DATE	DELIVERY MODE
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12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/577,036	Applicant(s) YAMAZAKI ET AL.	
	Examiner NANNETTE HOLLOMAN	Art Unit 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/20/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the Amendment filed on August 20, 2008. All previous rejections have been withdrawn unless stated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 112 – New Matter (New Rejection)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite the limitation "provided that R¹ and R² are not both benzoic acid residues". This limitation does not appear to be supported by the instant specification. The specification discloses wherein R¹ and R² independently indicate a hydrogen atom or a linear or branched fatty acid having 1 to 24 carbon atoms or a benzoic acid residue, but no disclosure of R¹ and R² not both being benzoic acid residues is disclosed. Therefore the limitation appears to be new matter.

Claim Rejections - 35 USC § 103 (Previous Rejections)

Claims 1-3 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 02/19977 A1). This rejection is maintained.

Applicant's Arguments

Applicant argues Mitsumatsu discloses pentaerythritol ester oil having a formula similar to those of the compounds used in Examples 1 and 2 and merely having pentaerythritol ester derived oil ingredients is insufficient to achieve desirable properties. Applicant further argues Mitsumatsu teaches away from the instant application by disclosing that the composition of Mitsumatsu is heated with a heating device to a temperature from about 30 °C to 60 °C and generally within that temperature range cosmetics such as lipsticks cannot be used with desirable results. This argument is not found persuasive.

Examiner's Response

In regards to the pentaerythritol ester oil, on page 27-28 the disclosed formula and R groups of Mitsumatsu et al. would reasonably lead one skilled in the art to the claimed composition because they are R groups encompassed by the instant claims. In regards to the heating of the composition would provide undesirable effects, it is disclosed that the composition and the heat generating agents can be packed in different compartments and therefore the composition would not be heated. Further, the scope of the rejected claims encompass more than lipstick.

Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 02/19977 A1) as applied to claims 1-3 above, and further in view of Healy et al. (WO 00/26285). This rejection is maintained and further applied to new claim 5.

Applicant's Arguments

See Applicant's argument and Examiner's response above in regards to Mitsumatsu et al. In regards to Healy et al., Applicant argues without acquiescing to the grounds of the rejection, claim 1 has been amended to recite that R^1 and R^2 are not both benzoic acid residues in the formula (I). Applicant further argues there is no motivation to combine because Mitsumatsu teaches away from lipstick and Healy does not suggest the property as recited in the instant application. This argument is not found persuasive.

Examiner's Response

In regards to Applicant's amendment, Healy discloses that R_1 and R_2 may be a phenol or hydrocarbyl, where hydrocarbyl can be methyl or ethyl, which would meet the limitation where R_1 and R_2 are not both benzoic acid residues.

Healy et al. as previously disclosed teach compounds that are structural homologs of the instantly claimed compounds, i.e. they differ only by CH_2 groups, and also disclose use as a lipstick. Therefore, one of ordinary skill in the art would have been motivated to prepare the instantly claimed compound because such structurally homologous compounds are expected to possess similar properties. It has been held

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that compounds that are structurally homologous to prior art compounds are *prima facie* obvious, absent showing of unexpected results. See MPEP 2144.09.

In regards to Applicant's asserted unexpected desired results of Table I and claim 5, the teachings of Mitsumatsu et al. in view of Healy et al. suggest Applicant's claimed invention and therefore it is noted that the functional properties are intrinsic to the composition and when the composition limitations are met, the properties intrinsic to the composition are met, i.e. it would be reasonably expected for the composition to improve gloss of lips after application of the composition to the lips. Furthermore Applicant's claims encompass more compounds than that disclosed by the Table in the specification, therefore the Examples are not commensurate in scope with the instant claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./

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/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612